

**REMARKS**

Claims 1-4, 7-8, 17, 19-38, 43-56, and 58-68 are pending in the application. Claims 66-68 have been added. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

**I. INTERVIEW SUMMARY**

Applicants wish to thank the Examiner for the interview conducted on September 8, 2010. During the interview, the Examiner and Applicants' attorney discussed the outstanding rejections of the claims under 35 U.S.C. §103. The specific matters discussed during the interview are addressed in the Remarks below.

**II. REJECTIONS UNDER 35 U.S.C. § 112**

Claim 58 stands rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Claim 58 has been amended in the self-explanatory manner seen above thereby obviating this rejection. Therefore reconsideration and withdrawal of the § 112, first paragraph rejection against Claim 58 is respectfully requested.

**III. REJECTIONS 35 U.S.C. §103**

Claims 1-3, 7-8, 17-19, 26-28, 30-32, 43-46, 47-48, 50-51, and 54-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0058471 to Okubo in view of U.S. Patent Publication No. 2004/0210894 to Zarco. Claims 4, 20-25, 33-34, 49, 52-53, 59, and 60-64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Okubo in view Zarco and in view of U.S. Patent Publication No. 2001/0034747 to Fujitani. Applicants respectfully traverse these rejections for at least the reasons set forth below.

#### A. Independent Claim 1

Amended independent Claim 1 recites a system that includes, in relevant part:

at least one memory comprising software, the software when executed performing a functionality for a print mechanism wherein the software is stored within a device that that includes the print mechanism,

the memory further comprising instructions executable by the processor to cause the processor to:

control a state of operation of the functionality where a first state is associated with an inability to execute the software so that the print mechanism does not perform the functionality...

receive user selection information from the user, the user selection information being indicative of a selection of the second state of operation of the functionality, the second state associated with an ability to execute the software so that the print mechanism performs the functionality...

receive second information from the server in response to the first information, where the second information enables execution of the software.

Emphasis added. At a minimum, the combination of Okubo and Zarco fails to disclose or suggest these underlined features.

In the rejection, the Office Action asserts that the image processing programs stored in the program memory 35 of the printer controller 10, depicted in Figure 3 of Okubo, discloses the "software" recited in independent Claim 1. Applicants respectfully disagree. The Okubo reference, at a minimum, fails to teach or suggest software, that when executed, performs a functionality for a print mechanism where a first state of operation of the functionality is associated with an inability to execute the software so that the print mechanism does not perform the functionality and a second state of the functionality is associated with an ability to execute the software so that the print mechanism performs the functionality where execution of the "software" is enabled based on the reception of second information from a server as recited in Claim 1.

Although the image processing programs (i.e., the alleged software recited in the claims) are stored locally (i.e., resident) on the print controller 10, the image processing programs do not control a functionality of the MFP 1 such that a first state of operation of the functionality of the MFP 1 is associated with an inability to execute the image processing programs as currently claimed. Rather, as noted in Okubo at paragraph 0085:

“[t]hese individual image processing programs enable the MFP 1 to perform various image processing operations in collaboration with hardware resources...initially provided thereto.”

As such, in Okubo, the individual processing programs stored in the program memory 35 are fully executable (i.e., not disallowed or restricted from execution) by dedicated hardware resources initially provided on the MFP 1. In other words, Okubo does not require any additional information (e.g., the recited “second information” received from the server) to enable or authorize performance of the individual processing programs.

Furthermore, Applicants respectfully submit that the individual processing programs retrieved by the enhancement control unit 19 to provide new functions or upgrade existing functions of the MFP 1 fail to teach or suggest all the features associated with the software recited in Claim 1. Paragraph 0114 described the enhancement operation performed in Okubo stating:

“the enhancement control unit 19 searches in the server 7 [for] one or more individual image processing applications to be newly added or to upgrade... When the individual image processing program found in the server 7 is determined as performable, the downloader 21 downloads the individual processing program to the program download memory 34. After that, the installer 32 adds or upgrades the downloaded individual image processing program into the program memory 35 in collaboration with the property manager 33. Thus, one or more individual image processing programs can be added or replace the old programs in the program memory 35.

Emphasis added. As clearly noted above, the enhancement operation performed in Okubo provides upgraded or new functionality to the MFP 1 based on the downloading of additional

image processing programs (i.e., programs separate and distinct from those initially provided on the MFP 1) from a server 7. In other words, the new or upgraded processing programs retrieved from the server 7 are not resident (i.e., locally stored) on MFP 1 as currently claimed. Rather the new or upgraded processing programs downloaded from the server 7 supplement or completely replace the “old programs” (i.e., the image processing programs initially provided on the MFP 1 discussed above) stored in the program memory 35. As such, the upgraded or new image processing programs described at paragraph 0114 of Okubo cannot be reasonably construed as showing or describing the software as currently recited in independent Claim 1.

Moreover, Zarco fails to remedy the foregoing shortcomings of Okubo. As noted in the Office Action, Zarco is merely relied upon to allegedly disclose receiving a list of selectable functionalities from a server. (Office Action, Page 16). Nothing in Zarco shows, describes, or even suggests the features of the claimed software discussed in detail above. For at least the reasons cited, Applicants respectfully assert that independent Claim 1 is patentably distinct from the combination of cited references. As such, Applicants respectfully request that this rejection of independent Claim 1 and its dependent claims be withdrawn.

#### **B. Independent Claim 17**

Independent Claim 17 recites a method for performing a functionality for a print engine based on the execution of software stored within a device that includes the print engine that includes, in relevant part, controlling a state of operation of the functionality where a first state is associated with an inability to execute the software so that the print engine does not perform the functionality, receiving user selection information from the user where the user selection information is indicative of a second state of operation of the functionality where the second state is associated with an ability to execute the software so that the print engine performs the

functionality, and receiving second information from a server in response to first information where the second information enables execution of the software. Independent Claim 17 recites features not shown or described in Okubo and Zarco, as discussed above with reference to Claim 1. As such, Applicants respectfully request that the rejection of independent Claim 17 and its dependent claims be withdrawn.

#### **C. Independent Claim 27**

Independent Claim 27 recites a method for performing a functionality for a functional unit based on the execution of software stored within a device that includes the functional unit that includes, in relevant part, controlling a state of operation of the functionality where a first state is associated with an inability to execute the software so that the functional unit does not perform the functionality, receiving user selection information from the user where the user selection information is indicative of a second state of operation of the functionality where the second state is associated with an ability to execute the software so that the functional unit performs the functionality, and, receiving from a server, second information in response to first information where the second information enables execution of the software. Independent Claim 27 recites features not shown or described in Okubo and Zarco, as discussed above with reference to Claim 1. As such, Applicants respectfully request that the rejection of independent Claim 27 and its dependent claims be withdrawn.

#### **D. Independent Claim 30**

Independent Claim 30 recites a system that includes, in relevant part, a processor and at least one memory comprising software that, when executed, performs a functionality for a functional unit where the software is stored within a device that includes the functional unit. The memory further includes instructions executable by the processor to cause the processor to

control a state of operation of the functionality where a first state is associated with an inability to execute the software so that the functional unit does not perform the functionality, receive user selection information, from a user, indicative of the second state of operation of the functionality where the second state is associated with an ability to execute the software so that the functional unit performs the functionality, and receive second information from a server in response to first information where the second information enables execution of the software. Independent Claim 30 recites features not shown or described in Okubo and Zarco, as discussed above with reference to Claim 1. As such, Applicants respectfully request that the rejection of independent Claim 30 and its dependent claims be withdrawn.

#### **E. Independent Claim 47**

Independent Claim 47 recites a system that includes, in relevant part, a processor and at least one memory that comprises software that, when executed, enables a modified capability level of a functionality for a print mechanism where the software is stored within a device that includes the print mechanism. The memory further includes instructions executable by the processor to cause the processor to control a state of operation of the functionality where a first state is associated with a first capability level of the functionality such that the print mechanism is operated in accordance with the first capability level where the first state is further associated with an inability to execute the software so that the print mechanism does not perform the modified capability level of the functionality, receive user selection information from the user where the user selection information is indicative of a second state of operation of the functionality where the second state is associated with an ability to execute the software so that the print mechanism performs the modified capability level of the functionality, and, receive second information from a server in response to first information where the second information

enables execution of the software. Independent Claim 47 recites features not shown or described in Okubo and Zarco, as discussed above with reference to Claim 1. As such, Applicants respectfully request that the rejection of independent Claim 47 and its dependent claims be withdrawn.

**F. Independent Claim 56**

Independent Claim 56 recites a method for enabling a modified capability level of a functionality for a print engine based on the execution of software where the software is stored within a device that includes the print engine, that includes, in relevant part, controlling a state of operation of the functionality where a first state of operation of the functionality is associated with an inability to execute the software so that the print engine does not perform the modified capability level of the functionality, receiving user selection information from the user where the user selection information is indicative of a second state of operation of the functionality where the second state is associated with the ability to execute the software so that the print engine performs the modified capability level of the functionality, and receiving second information from a server in response to first information where the second information enables execution of the software. Independent Claim 56 recites features not shown or described in Okubo and Zarco, as discussed above with reference to Claim 1. As such, Applicants respectfully request that the rejection of independent Claim 56 and its dependent claims be withdrawn.

**IV. CONCLUSION**

At least in view of the foregoing remarks, Applicants respectfully submit that the present application is in condition for allowance. Reconsideration is respectfully requested. If the Examiner has any questions, the Examiner is invited to contact the undersigned attorney at (312) 321-4200.

Respectfully submitted,

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Date

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